

Remarks

In the Office Action, claims 43 - 96 were noted as pending in the application, and all claims were placed under a restriction requirement. Species 15 of Group I of the restriction has been provisionally elected herein, but with traverse. The Applicants believe the restriction requirement of the September 7, 2004 Office Action is improper and respectfully request reconsideration of the restriction requirement and examination of original claims 43 - 96 in view of the following remarks.

Restriction Requirement

In items 2 - 4, on pages 2 - 4 of the Office Action, all claims, namely claims 43 - 96 were placed under a restriction requirement. Pursuant to 37 CFR § 1.143 and MPEP § 818.03, Applicants herein elect, with traverse, Group I and Species 15, corresponding to Figures 40 - 42. The claims corresponding to Group I and Species 15 are claims 43 - 64, 71 - 79, and 84 - 89.

Traversal of the Restriction Requirement

In items 1 - 3, on page 2 of the Office Action, a restriction requirement has been imposed on the claims. This restriction requirement is traversed as follows.

The claims have been classified into two groups, namely:

Group I Apparatus claims 43 - 64 and 71 - 91, allegedly drawn to an apparatus for filtering, classified in class 606, subclass 200.

Group II Method claims 65 - 70 and 92 - 96, allegedly drawn to a method of filtering, classified in class 606, subclass 200.

Class 606/200 is the classification for inventions directed toward surgery/with an embolic trap or filter. Notwithstanding the admitted common subject matter of the apparatus and method claims listed in Groups I and II, the Office Action asserts that the inventions recited in these two groups should be examined separately because (1) "the [method] as claimed can be practiced by another materially different apparatus . . . such as the apparatus does not require the capture ring or longitudinally extending through-wall slits as claimed in the group invention." However, comparing exemplary apparatus claim 59 and method claim 65, there is recited a capture ring in both claims; and neither claim recites "longitudinally extending through-wall slits." Instead, both claims recite a guide wire and a filter element

disposed on the guide wire such that rotation or distal translation of the guide wire does not displace the filter element when the filter element is deployed in the vessel. In short, because the apparatus claim does recite a capture ring and because neither the method claim nor the apparatus claim recites longitudinally extending through-wall slits, it cannot be said that the method claim can be practiced by a materially different apparatus in the manner asserted by the Office Action.

The Office Action also asserts that a restriction requirement is proper because (2) the apparatus as claimed can be used to practice another and materially different process in that “the apparatus as claimed can be used to practice . . . the process to filter or occlude other body lumen other than blood vessel.” The Office Action fails to document, contrary to the requirements of MPEP §806.05(e), which particular other body lumen other than a blood vessel can be processed by the specific apparatuses recited herein. The Office Action further fails to provide any support to the assertion that a process of providing a filter in a non-blood vessel lumen would constitute a “materially different process” than providing a filter in a blood vessel.

For the reasons presented above, the Applicants respectfully assert that the Examiner has failed to document a materially different process or apparatus in accordance with MPEP §806.05(e) that would warrant restricting the claims of the application.

The Office Action asserts in item 3, without support, that the claimed inventions have acquired a separate status in the art because of their recognized divergent subject matter and, therefore restriction for examination purposes is proper. By the Office Action’s own admission, all of the claims are properly classified in class 606/200 and, accordingly, are each directed to a common, not divergent, single subject matter. Accordingly, examination of both apparatus and method claims would be directed at the same subject matter and would not constitute an additional burden on the Examiner.

In item 4, on pages 3 - 4 of the Office Action, a further restriction requirement has been imposed. The claims have been classified among 15 species as indicated by various groupings of figures. The propriety of the restriction of the claims to 15 allegedly distinct species is respectfully traversed.


For the reasons discussed above, withdrawal of the restriction requirement and examination of all claims is respectfully requested.

Summary

It is submitted that all of the claims are directed to related inventions, namely apparatus and methods for filtering emboli, properly classified under Class 606, Subclass 200, and are easily searched and examined in their entirety without serious burden. In fact, the Office Action admits that all the claims are properly classified together in Class 606, Subclass 200. "If the search and examination of the entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP § 803. It is respectfully submitted that this policy should apply in the present application, where all claims are properly classified in the same class, in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office. Reconsideration of the restriction requirement, examination of all claims 43 - 96, and an action on the merits of all claims are earnestly solicited. If any fees are required in connection with this Amendment, please charge the same to our Deposit Account No. 02-4800.

Respectfully submitted,

Burns, Doane, Swecker & Mathis, L.L.P.

By: 
William N. Hugnet
Reg. No. 44,481

P.O. Box 1404
Alexandria, Virginia 22314-0404
Telephone: (703) 836-6620
Facsimile: (703) 836-2021

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